

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Page et al.	Art Unit : 2622
Patent No. : 7,605,844	Examiner : Dillon Durnford Geszvain
Issue Date : October 20, 2009	Conf. No. : 9861
Serial No. : 10/713,662	
Filed : November 13, 2003	
Title : IMAGING OPPOSING BOUND PAGES AT HIGH SPEED USING MULTIPLE CAMERAS	

Commissioner for Patents
P.O. Box 1450
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APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Patentees hereby request reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Reconsideration of the final PTA calculation to increase total PTA from 619 days to 1188 days is respectfully requested.

REMARKS

“A Delays” are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. “B Delays” are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. To the extent that the periods of delay overlap, the period of any term adjustment shall not exceed the actual number of days the issuance of the patent was delayed. 35 U.S.C. § 154(b)(2)(A). As outlined in Wyeth et al. v. Jon W. Dudas (580 F. Supp. 2d 138; 88 USPQ 2d 1538), the only way that these periods of time can “overlap” is if they occur on the same day. If an “A delay” occurs on one calendar day and a “B delay” occurs on another calendar day, they do not overlap and 35 U.S.C. § 154(b)(2)(A) does not limit the extension to one day. Id.

The PTA for the instant patent, as currently calculated and shown on the face of the patent, apparently relies on the premise that the application was delayed under 35 U.S.C. § 154(b)(1)(B) *before* the initial three-year period expired. The Wyeth v. Dudas court determined that this construction cannot be squared with the language of

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35 U.S.C. § 154(b)(1)(B), which applies “if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years.”

“B delay” begins only after the PTO has failed to issue a patent within three years, not before.

Id.

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

“A Delay”

A first PTO action was due on or before January 13, 2005 (the date that is fourteen months after November 13, 2003, the date on which the application was filed). The PTO mailed the first non-final Office Action on June 22, 2007, thereby according a PTO Delay of 890 days. Patentees do not dispute the PTO's calculation for this “A Delay” from January 14, 2005 (the day after the date that is fourteen months after the date on which the application was filed), to June 22, 2007. See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

In view of the period of “A Delay” detailed above, the total “A Delay” for this patent should be calculated as 890 days.

“B Delay”

The period beginning on November 14, 2006 (the day after the date that is three years after November 13, 2003, the date on which the application was filed), and ending October 20, 2009 (the date the patent was issued), is 1076 days in length.

“B Delay” may not include the number of days in the period beginning on the date on which a Request for Continued Examination was filed and ending on the date the patent was issued. In the present application, a Request for Continued Examination was filed on January 7, 2009. See 37 C.F.R. §§ 1.702(b)(1) and 1.703(b)(1). As such, a period of 286 days must be excluded from the “B Delay” calculation.

In addition, “B Delay” may not include the number of days in the period beginning on the date on which a Notice of Appeal was filed and ending on the date of mailing of a Notice of Allowance. See 37 C.F.R. §§ 1.702(b)(4) and 1.703(b)(4). In the present application, no Notice of Appeal was filed.

In view of the periods of "B Delay" detailed above, the total "B Delay" for this patent should be calculated as 790 days. The PTO calculated 0 days of delay for issuance of a patent more than three years after filing. Patentees respectfully submit that the PTO's calculation of this "B Delay" is incorrect and that the correct PTO Delay for issuance beyond three years from filing is 790 days. See 37 C.F.R. §§ 1.702(b) and 1.703(b).

Overlap of "A Delay" and "B Delay"

As detailed above, "A Delay" accumulated during the following period:

November 13, 2003, to June 22, 2007.

As detailed above, "B Delay" accumulated during the following period:

November 14, 2006, to January 6, 2009.

As such, the periods of "A Delay" and "B Delay" overlap (i.e., occur on the same calendar day) for a total of 221 days, from November 14, 2006, through January 6, 2009.

Applicant Delay

A reply to an Office Action was due on or before September 22, 2007 (the date that is three months after June 22, 2007, the date on which the Office Action was mailed). Patentees' response to the Office Action was received on January 22, 2008, thereby according an Applicant Delay of 122 days. Patentees do not dispute the PTO's calculation for this Applicant Delay from September 23, 2007 (the day after the date that is three months after the date on which the Office Action was mailed), to January 22, 2008. See 37 C.F.R. § 1.704(b).

A Notice of Non-Compliant Amendment was mailed May 29, 2008, indicating the response filed on January 22, 2007, contained an error or omission. A complete response correcting the error or omission was filed on June 12, 2008, thereby according an Applicant Delay of 142 days. Patentees do not dispute the PTO's calculation for this Applicant Delay from January 23, 2008, to May 29, 2008. See 37 C.F.R. § 1.704(c)(7).

A reply to an Office Action was due on or before May 20, 2009 (the date that is three months after February 20, 2009, the date on which the Office Action was mailed). Patentees filed a response to the Office Action on May 27, 2009, thereby according an Applicant Delay of

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7 days. Patentees do not dispute the PTO's calculation for this Applicant Delay from May 21, 2009 (the day after the date that is three months after the date on which the Office Action was mailed), to May 27, 2009. See 37 C.F.R. § 1.704(b).

Terminal Disclaimer

This patent is not subject to a terminal disclaimer.

Conclusion

In consideration of the events described above, Patentees believe the PTA calculation of 619 days is incorrect. As such, Patentees respectfully request reconsideration of the PTA in the following manner:

- 1) Total PTO Delay should be calculated as 1459 days (i.e., the sum of 890 days of "A Delay" and 790 days of "B Delay" minus 221 days of overlapping "A Delay" and "B Delay");
- 2) Total Applicant Delay should be calculated as 271 days (i.e., the sum of 122 days, 142 days, and 7 days); and
- 3) Total PTA should be calculated as 1188 days.

The fee of \$200 required under 37 C.F.R. § 1.18(e) is being submitted herewith. Please apply any other required charges or credits to Deposit Account No. 06-1050, referencing attorney docket number 16113-1308001.

Respectfully submitted,

Date: 21 Dec 09

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